

REMARKS

By this Amendment, Applicants amend claims 29, 31-34, and 36, and add new claim 39 to address other aspects of the present invention. Claims 29-39 are currently pending.

In the Office Action, the Examiner object to claim 33 as containing an informality; rejected claims 29-38 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,555,098 to Parulski ("Parulski");¹ and rejected claims 36-38 under 35 U.S.C. § 103(a) as being unpatentable over Parulski.²

Regarding the rejection under 35 U.S.C. § 102(b)

Applicants respectfully traverse the Examiner's rejection of claims 29-35 under 35 U.S.C. § 102(b) as being anticipated by Parulski. In order to anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Examiner did not discuss section 102(b) rejection of claims 36-38 in the item 5 of the Office Action, instead, the Examiner discussed only Section 103(a) rejection of claims 36-38 in the item 6 of the Office Action. Applicants treat the rejection of claims 36-38 as under Section 103(a).

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Independent claim 29, as amended,³ recites a combination including, for example, “the first management information includes a time search table configured to search for the stored audio information, [and] the second management information includes numeral information describing a number status of the still images.” Parulski fails to disclose at least these features of amended claim 29.

Parulski discloses that “digitized images and audio information are stored as image and audio data files in the manner of a library in a digital storage medium, i.e., data base. . . . Audio message may be associated with images, such that the audio message is played back while the image is displayed.” Parulski, column 4, lines 17-23. Further, Parulski states that “controller 26 accesses the corresponding sequence in the presentation sequences file 100 by its pointer entry in pointer table 110. The controller employs a pointer or other suitable program means for keeping its place in the program sequence section 160. As the pointer moves through the program sequence, the controller 26 reads the image IDs, one at a time. For each image ID, the controller 26 then goes to a file in FIG. 4, and reads the header and the image data file. Once the image has been read into image memory 32, controller 26 identifies the audio data files which follow the image file, and reads the audio files.” Parulski, column 8, lines 31-42, emphasis added. However, Parulski’s teaching of using a pointer to access an image file directly and its associated audio file indirectly does not constitute “the first

³ Support for the amendments may be found at, for example, pages 16 and 62 and Fig. 8 of the specification. In a particular example, management information includes a time search table, that is, time map information, such that the “time map information including information on a relationship between the reproduction time and the recording place (address)” may be used to search for stored audio information (lines 3-6, page 16 of the specification).

management information includes a time search table configured to search for the stored audio information,” as recited in amended claim 29 (emphasis added).

In addition, the Examiner alleges that Parulski discloses “the second management information includes numeral information describing a number status of the still images (Col 7, lines 23-26 ‘For example, the Program #1 address stored in location 112 of the presentation sequences file contains the address of location 122, which stores the disc image number of the first image for Program #1’).” (Office Action at 5.) Applicants respectfully disagree. An address of a stored program may be numeral information, however, Parulski’s merely teaching of program address does not constitute “the second management information includes numeral information describing a number status of the still images,” as recited in amended claim 29 (emphasis added).

Therefore, Parulski fails to disclose each and every element of amended claim 29. Parulski thus cannot anticipate amended claim 29 under 35 U.S.C. § 102. Accordingly, Applicants respectfully request withdrawal of the Section 102(b) rejection of amended claim 29. Because claim 30 depends from claim 29, Applicants also request withdrawal of the Section 102(b) rejection of claim 30 for at least the same reasons stated above.

Further, amended independent claims 31-34, while of different scope, include similar recitations to those of amended claim 29. Claims 31-34 are therefore also allowable for at least the same reasons stated above with respect to amended claim 29. Applicants respectfully request withdrawal of the Section 102(b) rejection of claims 31-34, and of claims 35, which depends from claims 34.

Regarding the rejection under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner's rejection of claims 36-38 under 35 U.S.C. § 103(a) as being unpatentable over Parulski, because a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

As set forth above, Parulski fails to teach or suggest "the management information of the audio information includes a time search table configured to search for the stored audio information, [and] the management information of the image information includes plural sets of management information items," as recited in amended claim 36. "The Examiner takes official notice that the use of semiconductor memory for storage of audio and image data is widely known and commercially available." (Office Action at 9.) However, even assuming the official notice is proper, which Applicants do not concede, Parulski fails to teach or suggest at least the above listed features of amended claim 36.

Therefore, Parulski fails to teach or suggest all elements of amended claim 36. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of amended claim 36.

Because claims 37 and 38 depend from claim 36, Applicants also request withdrawal of the Section 103(a) rejection of claims 37 and 38 for at least the same reasons stated above.

Regarding the claim objection

Regarding the Examiner object to claim 33 as containing an informality, Applicants have amended claim 33 to recite “a second recorder configured to . . . ,” as suggested by the Examiner, to correct the informality. Accordingly, Applicants respectfully request withdrawal of the objection to amended claim 33.

Regarding the newly added claim

Applicants have added new claim 39 to address another aspect of the present invention. Support for claim 39 may be found at, for example, page 77 of the specification. Because claim 39 depends from allowable amended claim 29, claim is also allowable over Parulski.

In addition, Parulski fails to disclose or teach at least “a bit setting configuration indicative of a representative image,” as recited in new claim 39. The Examiner alleges that Parulski discloses “the second management information includes numeral information describing a number status of the still images (Col 7, lines 23-26 ‘For example, the Program #1 address stored in location 112 of the presentation sequences file contains the address of location 122, which stores the disc image number of the first image for Program #1’).” (Office Action at 5.) However, such program address information does not constitute “a bit setting configuration indicative of a representative image,” as recited in new claim 39.

Conclusion

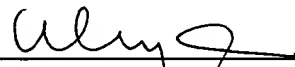
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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